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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,616	03/01/2004	Jost-Ulrich Kuegler	13287-002US2 / K27520PCUS	8845
26161	7590	05/11/2005	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			FRANCIS, FAYE	
			ART UNIT	PAPER NUMBER

3728

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

6

Office Action Summary	Application No. 10/790,616	Applicant(s) KUEGLER, JOST-ULRICH	
	Examiner Faye Francis	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-3 and 5-13 is/are rejected.
 7) ☒ Claim(s) 4 is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 5 is finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 5: the claim appears to be redundant since the new added limitation in this claim is already in claim 4 from which claim 5 depends.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 6-7 and 9-11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Papst in view of Chontos and Taylor and further in view of GB 1326711, hereinafter GB.

Papst discloses in the embodiment of Fig 3, a children's rocking toy in the form of a stylized horse, having a one-piece basic body [col 1 lines 14-18] made of flexible synthetic material [col 1 lines 14-34] which has a simply curved rocking surface forming the base [frame 15] of the rocking toy and a seat region 21 molded [col 2 lines 37] into it, the basic body has, at its two longitudinal end regions, two curvatures in the form of a

Art Unit: 3728

horse's head 21a and of a horse's rear part 21b, respectively, each curvature having a height relatively greater than the molded-in seat region, the cross section of the basic body widens from its upper, narrow side, which forms the horse's head, seat region and horse's rear part, towards the curved rocking surface in a continuous and uniform contour of the side surfaces [Fig 3] as recited in claim 1.

Papst does not disclose the seat region is molded a good distance into the basic body and thereby forms a backrest region and the flexible synthetic material is a foam as recited in claim 1, the basic body is manufactured, in particular cut, from a foam block as recited in claim 6 and the basic body is covered with a fabric covering as recited in claim 7 and the rocking surface has a non-slip backing made of leather or imitation leather and the backing is connected to the basic body by a zipper fastener or by button or snaps or by a belt or strap with an overhang and eyelet for exchanging or for cleaning or washing purposes as recited in claim 9.

Chontos teaches the concept of providing a rocking horse with shock absorbing non-slip surface [rubber 44] attached to its lower extremities. It would have been obvious to provide the curved rocking surface in the device of Papst to include the non-slip backing as disclosed by Chontos, in order to prevent the device from sliding.

Taylor teaches that using roughened leather to make a non-slip surface is conventional. It would have been obvious to further make the non-slip backing out of roughened leather as disclosed by Taylor, in order to prevent the device from sliding and to make it work silently. Additionally, it would have been obvious to connect the backing to the curved rocking surface by way of a zipper fastener or by button or snaps

or by a belt or strap in order to prevent "premature separation" of the backing from the curved rocking surface.

With respect to the seat region is molded a good distance into the basic body and thereby forms a backrest region, Papst discloses in the embodiment of Fig 1 the seat region is molded a good distance into the basic body. It would have been obvious to modify the seat region in the embodiment of Fig 3 in device of Papst to be molded a good distance into the basic body as disclosed by the embodiment of Fig 1 of the same reference, in order to ensure safe handling and operation by a child.

GB is cited to show a desirability to make a rocking toy made out of a block of foam covered with a fabric covering [waterproof sheet material or fabric] [col 1 last two lines]. It would have been obvious to make the device of Papst out of a block of foam as disclosed by GB in order to make the device safe for the children by avoiding hard or sharp edges. Also, it would have been obvious to provide the device with waterproof sheet material or fabric to make the device suitable for outdoor play.

5. Claim 12 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Papst, Chontos, Taylor and GB and further in view of Curry, Sr., hereinafter Curry.

Modified device of Papst discloses most of the element of this claim as applied to claims 1-3, 6-7 and 9-11 above but does not disclose the tail and the mane of the horses head consist of real, artificial or stylized hairs.

Curry teaches the concept of providing a rocking horse in which the tail and the mane of the horse's head consist of artificial hairs [col 7 line 44]. It would have been

Art Unit: 3728

obvious to further provide the rocking horse of Curry with artificial hairs in its tail and mane as disclosed by Curry in order to make the device more realistic.

6. Claims 8 and 13 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Papst, Chontos, Taylor and GB and further in view of Official Notice hereby taken that having seat region has a leather layer as the saddle is well known in the art.

Modified device of Papst has most of the elements of claim 8 as applied to claims 1-3, 6-7 and 9-11 above but does not disclose the seat region has a leather layer as the saddle.

In view of Official Notice above it would have been obvious to provide the device of Papst with a leather saddle in order to have a more comfortable seat. [see also US Patent number 4,848,067]

Response to Arguments

7. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument on top of page 6 regarding the rejection of claims 1-2, 6-7 and 9-11, the examiner would like to point out that Taylor reference has been applied only to show that using roughened leather to make a non-slip surface is conventional.

In response to applicant's argument that there is no teaching in the prior art to make the combination.

The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re Simon, 174 USPQ 114 (CCPA 1972); In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969).

The question under 35 USC §103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989) and *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. *In re Beattie*, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992); *In re*

Art Unit: 3728

Dillon, 919 F.2d 688, 16 USPQ2d 1897, 1905 (Fed. Cir. 1990); In re Kronig, 539 F.2d1300, 190 USPQ 425 (CCPA 1976); In re Wilder, 429 F.2d 447, 166 USPQ 545 (CCPA 1970).

In this case, the artisan would have been motivated to modify Papst's device to provide the curved rocking surface to include the non-slip backing in order to prevent the device from sliding and further make the non-slip backing out of roughened leather in order to prevent the device from sliding and to make it work silently. Additionally, the artisan would have been motivated to connect the backing to the curved rocking surface by way of a zipper fastener or by button or snaps or by a belt or strap in order to prevent "premature separation" of the backing from the curved rocking surface and to make the device of Papst out of a block of foam in order to make the device safe for the children by avoiding hard or sharp edges.

Allowable Subject Matter

8. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

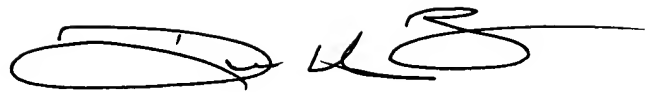
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/790,616
Art Unit: 3728

Page 9

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A handwritten signature in black ink, appearing to read 'D. H. Banks', with a long horizontal flourish extending to the right.

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
BIOLOGY CENTER 3700